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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/175,589	10/20/1998	ANDREA M. JACOBSON	12369.5US01	7081

7590 06/02/2005

MOORE HANSEN & SUMNER PLLP
225 SOUTH SIXTH STREET
SUITE 4850
MINNEAPOLIS, MN 55402

EXAMINER	
COLBERT, ELLA	

ART UNIT	PAPER NUMBER
3624	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/175,589	JACOBSON, ANDREA M.	
	Examiner	Art Unit	
	Ella Colbert	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 February 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-26 are pending. Claims 1, 4, 5, 13, 17-23 have been amended and claims 24-26 have been added in this communication filed 02/28/05 entered as Response After Non-Final Action.

2. The Change in Power of Attorney and Correspondence Address Change filed 03/15/05 has been entered.

3. The Applicant's amendment to claims 1 and 5 has overcome the rejected under 35 U.S.C. 112, second paragraph and is hereby withdrawn.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over "http://www.ustrim.com/trim/page 31.htm", hereafter ustrim in view of (US 6,108,688) Nielsen.

With respect to claim 1, USTrim teaches, creating an electronic tag that uniquely identifies the electronic record, the electronic tag being associated with a deletion prevention time period (See "Retention and Disposal of Records" page 1) for compliance with the pre-determined network security rules (see "publishing records on the WWW" page 1 and "Security and Privacy of Records" page 1 and "Functional Security" pages 1 and 2); storing the at least one electronic tag in a central repository

(see "Record Navigation" page 1, "WWW Access to TRIM DataBases" page 1, and "Publishing Records on the WWW" page 1).

Ustrim failed to teach, sending the electronic record from the distributed computing environment to a recipient. Nielsen teaches, sending the electronic record from the distributed computing environment to a recipient (col. 2, lines 57-66). It would have been obvious to one having ordinary skill in the art at the time the invention was made to send the electronic record from a distributed computing environment to a recipient and to modify in Ustrim in view of Ustrim's teachings of an electronic tag and electronic documents and because such a modification would allow Ustrim to be addressed to a recipient and to arrive at the recipient's computer terminal with minimal information about the message.

Ustrim teaches, automatically denying a request to delete the electronic record before expiration of the deletion prevention time period associated with the electronic tag (page 1, "Retention & Disposal of Records" (also see fig. of screen shot) and "Automatic Disposition Management" pages 1 and 2)). Ustrim did not expressly disclose automatically denying a request to delete the electronic record before expiration of the deletion prevention time period. However, Ustrim shows in a figure of the screen shot of a 2 year archive and destroying after 6 years. Nielsen teaches, a date and time in fig. 2. It is well known in the art of electronic mail and network security that electronic mail documents are either deleted, purged, archived or destroyed after a period of time.

6. Claims 2-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ustrim and Nielsen in view of (EP O346556) Mourier.

With respect to claim 2, Ustrim and Nielsen failed to teach, further comprising deleting the electronic record and selectively deleting the at least one electronic tag.

Mourier teaches, further comprising deleting the electronic record and selectively deleting the at least one electronic tag (col. 9, lines 47-55 and lines 59-68 and fig. 19B). It would have been obvious to one having ordinary skill in the art at the time the invention was made to delete the electronic record and selectively delete the at least one electronic tag and to modify in UStrim because such a modification would allow UStrim to have the tag transferred into the "To Be Answered" file and deleted from the "To Be Assigned" file (purging the electronic record comprising the steps of deleting the electronic record).

With respect to claim 3, UStrim teaches, further comprising storing the electronic record ("WWW Access to Trim DataBase" page 1).

With respect to claim 4, Ustrim teaches, determining whether the request is consistent with the network security policy ("Security and Privacy of Records" page 1).

With respect to claim 5, Ustrim and Nielsen failed to teach, wherein the distributed computing environment comprises a computer having a registry and a user profile, and wherein creating the electronic tag comprises generating a reference code and creating the electronic tag at least in part as a function of at least one of the registry, the user profile, and the reference code. Mourier teaches, wherein the distributed computing environment comprises a computer having a registry and a user

profile, and wherein creating the electronic tag comprises generating a reference code and creating the electronic tag at least in part as a function of at least one of the registry, the user profile, and the reference code (col. 4, lines 12-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the distributed computing environment comprise a computer having a registry and a user profile, and wherein creating the electronic tag comprises generating a reference code and creating the electronic tag at least in part as a function of at least one of the registry, the user profile, and the reference code and to combine Ustrim's electronic tag that uniquely identifies the electronic record with Mourier's distributed computing environment comprising a computer having a registry and a user profile, and wherein creating the electronic tag comprises generating a reference code and creating the electronic tag at least in part as a function of at least one of the registry, the user profile, and the reference code because such a combination would allow Ustrim to manage electronic mail without wasteful memory space and without having a time-consuming process to retrieve saved electronic mail.

With respect to claim 6, UStrim and Nielsen failed to teach, generating the reference code comprises reading the electronic record. Mourier teaches, generating the reference code comprises reading the electronic record (page 7, lines 16-47). It would have been obvious to one having ordinary skill in the art at the time the invention was made to generate the reference code comprising reading the electronic record and to modify in UStrim because such a modification would allow Nielsen to have a special

memory section within his machine, memory section he may access on a read/write basis.

With respect to claim 7, this dependent claim is rejected for the similar rationale given for claim 6.

With respect to claim 8, UStrim and Nielsen failed to teach, wherein the index code identifies the contents of the electronic record and the recipient of the electronic record. Mourier teaches, an index code identifying the contents of the electronic record and the recipient of the electronic record (page 7, lines 1-56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the index code identify the contents of the electronic record and to modify in UStrim because such a modification would allow UStrim to have a command that sorts (index) the files by updated dates (index code).

With respect to claim 9, UStrim failed to teach, wherein the index code identified the contents of the electronic record and the recipient of the electronic record. Nielsen teaches, wherein the index code identified the contents of the electronic record and the recipient of the electronic record (col. Col. 1, lines 7-41). The nature of E-mail does not entitle any patentable weight and is considered a design choice.

With respect to claim 10, UStrim and Nielsen failed to teach, reading a stored electronic tag; and generating an electronic tag in response to accessing an electronic record. Mourier teaches, reading a stored electronic tag; and generating an electronic tag in response to accessing an electronic record (Page 8, lines 9-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made

to read a stored electronic tag and generating an electronic tag in response to accessing an electronic record and to modify in UStrim because such a modification would allow UStrim to have a subject and to have a message with the sender code and a recipient code.

With respect to claim 11, this dependent claim is rejected for the similar rationale given for claim 9.

With respect to claim 12, this dependent claim is rejected for the similar rationale given for claims 5 and 6.

With respect to claim 13, UStrim and Nielsen failed to teach, a computer system comprising at least one processor and at least one memory. Mourier teaches, a computer system comprising at least one processor and at least one memory (page 3, lines 1-18 and lines 46-49). This independent claim is rejected for the similar rationale as given above for claim 1.

With respect to claim 14, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 15, this dependent claim is rejected for the similar rationale given for claim 4.

With respect to claim 16, this dependent claim is rejected for the similar rationale given for claim 5.

With respect to claim 17, this independent claim is rejected for the similar rationale given for claim 1.

With respect to claim 18, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 19, this dependent claim is rejected for the similar rationale given for claim 3.

With respect to claim 20, this dependent claim is rejected for the similar rationale as given above for claim 4.

With respect to claim 21, this independent claim is rejected for the similar rationale given for claim 5.

With respect to claim 22, this independent claim is rejected for the similar rationale given for claim 6.

With respect to claim 23, this independent claim is rejected for the similar rationale as given above for claims 1, 13, and 17.

With respect to claim 24, UStrim and Nielsen failed to teach, The method of claim 1, further comprising overriding the denial of the request to delete the electronic record before expiration of the deletion prevention time period associated with the electronic tag when the request is received from a user having a security privilege to override the denial. Mourier teaches, The method of claim 1, further comprising overriding the denial of the request to delete the electronic record before expiration of the deletion prevention time period associated with the electronic tag when the request is received from a user having a security privilege to override the denial (col. 6, lines 30-38). It would have been obvious tone having ordinary skill in the art at the time the invention was made to override the denial of the request to delete the electronic record

before expiration of the deletion prevention time period associated with the electronic tag when the request is received from a user having a security privilege to override the denial and to modify in UStrim because such a modification would allow UStrim to have a recovery procedure to override the deletion time period for the deletion of an electronic record associated with an electronic tag.

With respect to claim 25, this dependent claim is rejected for the similar rationale as given above for claim 24.

With respect to claim 26, this dependent claim is rejected for the similar rationale as given above for claims 24 and 25.

Response to Arguments

7. Applicant's arguments filed 02/28/05 have been fully considered but they are not persuasive.

Issue no. 1: Applicant argues: Claim 1 recites a method in which a request to delete an electronic record before expiration of a deletion prevention time period is denied and rather than automatically deleting an electronic record, the method recited in claim 1 automatically denies a premature deletion request, thereby preserving the electronic record until its deletion is consistent with network security rules has been considered but is not persuasive. Response: Applicant appears to be arguing the amendment to claim 1. However, UStrim teaches in "Retention and Disposal of Records" that "authorities must have trigger events which assist with the process of determining when records may be sent to inactive storage, destroyed or archived" and "a good electronic record keeping system will provide record sentencing, retention and

disposal functions." Also, in the section, "Automatic Disposition Management" UStrim teaches "Records must be retained in off site storage or be destroyed according to legal retention schedules" on page 1. UStrim discusses "legal retention schedules" which is interpreted to mean that deletion of an electronic record before expiration of a deletion prevention time period is denied". The wording of this claim limitation is somewhat confusing because it is not understood how the electronic tag is associated with a deletion prevention time period and the request to delete the electronic record before the expiration of the deletion prevention time period is automatically denied.

Applicant is respectfully requested to point out in the Specification where a request to delete an electronic record before expiration of a deletion prevention time period is denied and automatically denying a premature deletion request, thereby preserving the electronic record until its deletion is consistent with network security rules.

Conclusion: In this rejection of claim 1 and others, for example under Section 103 (a) of Title 35 of the United States Code, the Examiner carefully drew up a correspondence between the Applicants' claimed limitations and one or more referenced passages in the UStrim, Nielsen, and Mourier references, what is well known in the art, and what is known to one having ordinary skill in the art (the skilled artisan). The Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).<

Applicant is respectfully requested to point out to the examiner and in the independent claims the inventive concept of the invention and to distinctly and clearly claim that inventive concept in the claim language.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

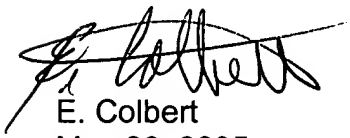
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday-Thursday, 6:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert
May 26, 2005